REPLY UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER, ART UNIT 3622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Barik, Rajkishore et al.	Atty. Docket No.: JP920000376US1
Serial No.: 09/772,244	Group Art Unit: 3622
Filed: January 29, 2001	Examiner: Carlson, Jeffrey

For: **ELECTRONIC COUPONS DECISION SUPPORT AND RECOMMENDATION SYSTEM**

MAIL STOP AF
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §1.116

Sir:

In response to the Examiner's Answer mailed on **July 20, 2010** in response Appellant's

Appeal Brief filed on **April 6, 2010**, please consider this timely filed Reply Brief in the above-

identified application as follows:

STATUS OF THE CLAIMS

[0001] Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70, all the pending claims of the invention, are under appeal.

[0002] The Examiner's Answer mailed on **July 20, 2010** sustains the following rejections.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Marmon, U.S. Pat. No. 4,446,528.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Marmon U.S. Pat. No. 4,446,528 and Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728 and Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further

in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728 and Marmon, U.S. Pat. No.

4,446,528.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over

Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No.

2002/0013728, Marmon U.S. Pat. No. 4,446,528 and Beach et al., U.S. Pat. App. Pub. No.

US2002/10107738.

[0003] Appellant respectfully traverse the rejections based on the following discussion and

Appellant's previous arguments.

I.   **RESPONSE TO EXAMINER'S ANSWER ARGUMENTS**

        A.   **SUMMARY OF INVENTION**

[0004] The present invention describes an invention directed toward recommending to a user to

use an additional e-coupon in relation to a purchase based on choosing one particular saved set of

e-coupons.

[0005] The claimed invention assists a shopper in choosing a subset of coupons, for use in a

given purchase, from a number of coupons available to the shopper, where the invention aims to

provide an enhanced coupon-using experience and a user-friendly coupon management system

by issuing suggestions or recommendations based on optimal or near optimal stored coupon

subsets.

[0006] The claimed invention allows a shopper to click on the link to save an electronic coupon,

which may be saved on the shopper's desktop, a third party coupon wallet service provider, or

with the store offering the coupons, for example. The shopper can either use the saved selected

set of coupons and further process the order, or choose to select another saved combination of

coupons and save the current combination for future comparison. If the shopper's selected

coupons cannot be used, the system queries the shopper to select another set of coupons. The

process continues until the shopper selects and chooses to use a set of non-mutually exclusive

coupons.

B.   APPELLANT'S RESPONSE TO EXAMINER'S ARGUMENTS

[0007] 1.   On page 26 of the Reply Brief mailed on July 20, 2101, the Examiner alleges that

it would be obvious to modify Fajkowski to arrive at the claimed invention, since "Both are

concerned with automated and electronic coupon redemption systems."

[0008] However, Appellant's fails to understand what the Examiner's use of the term "both" is

regarding. Applicant assumes that "both" refers to one of the references used in combination

with Fajkowski, *i.e.*, either Wilkman or Marmon. Therefore, given the ambiguous nature of the

Examiner's response, Appellant will address each reference.

[0009] Regarding the Marmon reference, Appellant fails to understand what elements of

Appellant's claimed invention Fajkowski fails to teach or suggest that necessitate a combination

with the Marmon reference. Alternatively stated, Applicant maintains that the Examiner's

rejection over the combination of Wajkowski and Marmon is NOT proper since the Examiner

fails to identify what elements of Appellant's claimed invention are NOT taught by Fajkowski

and which elements of Marmon teach those missing elements and why one of ordinary skill in

the art would have combined the references based on either teaching within the references or the

demonstration with evidence of the level of one of ordinary skill in the art.

[0010] Regarding the Wilkman reference, Appellant fails to understand what elements of

Appellant's claimed invention Fajkowski fails to teach or suggest that necessitate a combination

with the Wilkman reference. Alternatively stated, Applicant maintains that the Examiner's

rejection over the combination of Wajkowski and Wilkman is NOT proper since the Examiner

fails to identify what elements of Appellant's claimed invention are NOT taught by Fajkowski

and which elements of Wilkman teach those missing elements and why one of ordinary skill in

the art would have combined the references based on either teaching within the references or the

demonstration with evidence of the level of one of ordinary skill in the art.

[0011] 2.   On page 27 of the Reply Brief mailed on July 20, 2101, the Examiner alleges:

> Fajkowski scans products to determine products under consideration for purchase,
> so that the scanned products (not yet purchased) can be compared to the coupons
> offered for redemption during the purchase. The coupons are certainly not
> redeemed by the cash register after the purchase is finalized, but before - so that
> the consumer can reduce his purchase price. Fajkowski uses the term purchase
> data and items purchased to refer to items scanned, but not paid for (i.e. not
> purchased; i.e. "before purchase"). Applicant points to the top of column 17 of
> Fajkowski and fig 15a, yet if applicant would consider the bottom of Column 17
> and companion figure 15b, he would see that Fajkowski scans products, considers
> coupons for redemption, then finalizes the current purchase.

[0012] Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before

a purchase, and in fact, teaches away from Appellant's claimed invention by disclosing that the

"products were purchased by the consumer," thereafter, a "list of redeemable coupons will then

be displayed on the periphery device." (Emphasis added.) See column 4, lines 26-35. The

Examiner's statement on page 25 of the Non-Final Office Action is completely contrary to the

plain meaning of the description of Fajkowski. The disclosure of column 17 in Fajkowski that

the Examiner alludes to merely states that, "If the customer is satisfied that display screen 102

shows all his redeemable coupons, the cashier will again press the "List/Send" key 108 and the

redeemable coupon bar codes 50 will be transferred to cash register 150 (step 176)." Nowhere in

this passage, or anywhere else in Fajkowski is there any teaching or suggestion that the

redeemable coupons are "transferred to cash register 150" *before said user makes said purchase,*

which is consistent with Fajkowski's disclosure stated above that the "list of redeemable coupons

will then be displayed" once the "products were purchased by the consumer." The Examiner

cannot interject his own ideas of what he would like to see the reference teach when the

reference clearly teaches something to the contrary, no matter how awkward that disclosure may

be.

[0013] Appellant's claimed invention is directed toward a *combination of non-mutually exclusive*

e-coupons, and another *sub-set of the e-coupons*. The disclosure of Fajkowski cited by the

Examiner on column 13, lines 14-42, details either immediately after scanning the coupon or

after a coupon has been stored in RAM means 23 the user selects particular coupons to

"segregate" them to a "shopping list". More specifically, Fajkowski discloses at column 13,

lines 15-17, "This routine will allow the user to segregate coupons for specific products that the

user desires to purchase during a future shopping trip." Therefore, it is the "user" that segregates

the coupons to a "shopping list" and not, a computer implemented method of, "*outputting a*

suggestion to said user, by said computer, displaying said most favorable combination of non-

mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons," per

Appellant's claimed invention.

[0014] However, using the Examiner's logic of equating the elements of Fajkowski with

Appellant's claimed invention, nowhere in Fajkowski, nor in any other cited art of record is there

any teaching or suggestion that demonstrates choosing either the "shopping list" of user-

segregated coupons OR the rainchecked marked coupons based on comparing the user-

segregated coupons and the rainchecked marked coupons, per Appellant's claimed invention.

The user-segregated coupons are used after the user has purchased the items per Fajkowski's

disclosure at column 17, and the raincheck marked coupons are used to merely allow a customer

to "utilize the coupon after its expiration date," from column 20, lines 39-47. <u>There is no</u> <u>comparison between either of these "lists," since each "list" is disclosed as being used</u> <u>independently of the other</u>. Though the "raincheck" marked coupons are generated from the predetermined user-segregated coupon "shopping list" upon the determination of one or more item's unavailability at the time of sale, <u>neither list is compared to the other for the purposes of</u> <u>choosing to use one list over other the other in a checkout POS transaction</u>.

[0015] 3.   On page 27 of the Reply Brief mailed on July 20, 2101, the Examiner alleges that "Applicant argues that because Fajkowski appears to teach certain coupons applicable to the same product but which may not be redeemed together, that Fajkowski teaches away from coupons that can be used together." However, nowhere does Appellant argue that "Fajkowski teaches away from coupons that can be used together."

[0016] However, Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before a purchase, and in fact, teaches away from Appellant's claimed invention by disclosing that the "products <u>were purchased</u> by the consumer," thereafter, a "list of redeemable coupons <u>will then be displayed</u> on the periphery device." (<u>Emphasis added</u>.) See column 4, lines 26-35.

[0017] 4.   On page 28 of the Reply Brief mailed on July 20, 2101, the Examiner alleges "applicant's system is taken to be programmed essentially by creating a systemic approach to evaluating the coupon redemption combinations. These evaluations can be done manually and in fact have been done for years by both consumers and POS clerks or POS systems responsible for preventing fraudulent redemption as recognized by applicant."

[0018] Appellant's claimed invention is directed toward a *combination of non-mutually exclusive* *e-coupons*, and another *sub-set of the e-coupons*. The disclosure of Fajkowski cited by the

Examiner on column 13, lines 14-42, details either immediately after scanning the coupon or

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"segregate" them to a "shopping list". More specifically, Fajkowski discloses at column 13,

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user desires to purchase during a future shopping trip." Therefore, it is the "user" that segregates

the coupons to a "shopping list" and not, a computer implemented method of, "*outputting a*

suggestion to said user, by said computer, displaying said most favorable combination of non-

mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons," per

Appellant's claimed invention.

[0019] 5.   On page 29 of the Reply Brief mailed on July 20, 2101, the Examiner alleges

"Applicant argues that the art does not teach a user defining optimization parameters and display

of eligible coupons satisfying the criteria," wherein the Examiner alleges that "that one of

ordinary skill would find it obvious that rather than choose the best coupons manually (as

admitted has happened in the past), to automate the recognized difficult, and/or time consuming

tasks of choosing the best coupon for that user's desires."

[0020] Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before

a purchase, and in fact, teaches away from Appellant's claimed invention by disclosing that the

"products <u>were purchased</u> by the consumer," thereafter, a "list of redeemable coupons <u>will then</u>

<u>be displayed</u> on the periphery device." (<u>Emphasis added</u>.) See column 4, lines 26-35. The

Examiner's statement on page 25 of the Non-Final Office Action is completely contrary to the

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which is consistent with Fajkowski's disclosure stated above that the "list of redeemable coupons

will then be displayed" once the "products were purchased by the consumer." The Examiner

cannot interject his own ideas of what he would like to see the reference teach when the

reference clearly teaches something to the contrary, no matter how awkward that disclosure may

be.

[0021] 6.   On page 30 of the Reply Brief mailed on July 20, 2101, the Examiner alleges that

"Marmon is actually closely related with coupon decision making and suggesting coupon usage

that would be optimum for the user."

[0022] Appellant fails to understand what elements of Appellant's claimed invention Fajkowski

fails to teach or suggest that necessitate a combination with the Marmon reference. Alternatively

stated, Applicant maintains that the Examiner's rejection over the combination of Wajkowski and

Marmon is NOT proper since the Examiner fails to identify what elements of Appellant's

claimed invention are NOT taught by Fajkowski and which elements of Marmon teach those

missing elements and why one of ordinary skill in the art would have combined the references

based on either teaching within the references or the demonstration with evidence of the level of

one of ordinary skill in the art.

[0023] 7.   On page 30 of the Reply Brief mailed on July 20, 2101, the Examiner cites

Chore-Time Equipment, Inc. v. *Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir.

1983), as a basis to not provide "the requisite evidence of the level of one of ordinary skill in the

art to [provide for applicant's claim language]," as Appellant maintains.

[0024] Appellant maintains that the Examiner failed to comply with 35 U.S.C. §103 that

authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to

combine it with one or more other references, wherein the examiner should set forth in the Office

action:

(A)   the relevant teachings of the prior art relied upon, preferably with reference to the

relevant column or page number(s) and line number(s) where appropriate,

(B)   the difference or differences in the claim over the applied reference(s),

(C)   the proposed modification of the applied reference(s) necessary to arrive at the

claimed subject matter, and

(D)   an explanation as to why the claimed invention would have been obvious to one

of ordinary skill in the art at the time the invention was made. (M.P.E.P. §706.02(j), *et seq.*)

[0025] Therefore, Appellant respectfully requests the Board to withdraw this rejection since the

alleged prior art reference to Fajkowski, Wilkman, Marmon and Beach fail to teach or suggest

each element and feature of Appellant's claimed invention. Furthermore, Appellant respectfully

submits that dependent claims, which depend from the above-identified independent claims, are

similarly patentable over Fajkowski, Wilkman, Marmon and Beach.

II.   FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Thus, the Appellant respectfully requests the Board reconsider and withdraw the rejections of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70 and pass these claims to issue.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: <u>September 15, 2010</u>
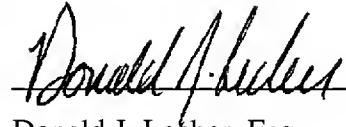
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